

REMARKSClaims 1-5, 8, 11-14, 17, 20-22 and 25

Claims 1-5, 8, 11-14, 17, 20-22 and 25 have been rejected under 35 USC 102(e) as being anticipated by Koyanagi et al. (US6785090).

Regarding claim 1, Applicants respectfully disagree that Koyanagi anticipates claim 1. Particularly, Koyanagi fails to teach each and every limitation of claim 1.

"A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference."

Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). Moreover, the identical invention must be shown in as complete detail as contained in the claim. *Richardson v. Suzuki Motor Co.* 868 F.2d 1226, 1236, 9USPQ2d 1913, 1920 (Fed. Cir. 1989). The elements must be arranged as required by the claim. *In re Bond*, 910 F.2d 831, 15 USPQ2d 1566 (Fed. Cir. 1990).

Applying these rules to the present case, it will soon become apparent that claim 1 is distinguishable from Koyanagi. Claim 1 requires that the upper and lower layers are fixedly coupled together. This means that the composite ring thus formed, is a unitary part. The unitary nature of the claimed ring is further defined by the preamble referring to the ring as a "composite" ring.

In sharp contrast, Koyanagi's top clamp 21 and clamp ring 51 are individual and separable parts. The claimed invention seeks to reduce the propensity for deformation and higher fabrication and assembly costs associated with separable parts. These issues are discussed at p. 3, line 6 to p. 4, line 8 of the present application and summarized below.

A drawback of the separable parts, as in Koyanagi, is that when the bolts are tightened, the top clamp and spacer become deformed due to the uneven pressures exerted by the individual bolts. The deformation translates out to the disk, creating an uneven "wavy" disk surface, which is most prominent at the inner diameter of the disk. Any unevenness (waviness) on the disk surface compounds the tendency to lose the

servo, especially near the inner diameter zone closest to the spacer ring. Further, it has been found that stresses induced on the top disk in the stack transfer down and propagate into some or all of the remaining disks in the stack. Thus, it would be desirable to reduce uneven stresses at the top disk so that the remaining disks remain flat.

The claimed composite spacer overcomes this problem by providing a composite spacer that distributes stresses evenly due to its layered construction.

Another issue with individual clamps (21) and spacers (51), as in Koyanagi, is the high cost of assembling the drives. Each spacer must be placed in the drive and then the top clamp added and bolted down. This process is time consuming.

The claimed invention reduces assembly costs by coupling the top clamp and top spacer ring together so that they can be placed in the drive at the same time. This saves a processing step in that only one piece (top clamp-spacer composite) need be handled instead of two parts (top clamp and spacer ring individually). The cost savings obtainable by using a composite structure is dramatically increased in new high capacity drives which require only a few disks as opposed to several. For example, in a drive with five disks, five parts must be handled: the top clamp-spacer composite and four more spacer rings. In a drive with only two disks, only two parts are handled: the top clamp-spacer composite and one spacer between the disks.

Additional cost savings are realized by the present invention in that it is no longer necessary to machine two surfaces in such a way to match flatness during manufacture of the top clamp and top spacer ring themselves, as required in assemblies such as that shown in Koyanagi.

Accordingly, it is apparent that Koyanagi does not meet the requirements of claim 1. Reconsideration and allowance of claim 1 is respectfully requested.

Claims 2-5, 8, 11 and 25 depend from claim 1, and are therefore also believed to be allowable.

Regarding claim 12, Applicants respectfully disagree that Koyanagi anticipates claim 12. Particularly, Koyanagi fails to teach each and every limitation of claim 12, particularly that the lower layer is fixedly coupled to the upper layer, as discussed in detail above in the discussion of claim 1. For the same reasons as set forth above for claim 1, claim 12 is believed to be allowable. Reconsideration and allowance of claim 12 is respectfully requested.

Claims 13, 14, 17, and 20 depend from claim 12, and are therefore also believed to be allowable.

Regarding claim 21, Applicants respectfully disagree that Koyanagi anticipates claim 21. Particularly, Koyanagi fails to teach each and every limitation of claim 21, particularly that the lower layer is fixedly coupled to the upper layer, as discussed in detail above in the discussion of claim 1. For the same reasons as set forth above for claim 1, claim 21 is believed to be allowable. Reconsideration and allowance of claim 21 is respectfully requested.

Claim 22 depends from claim 21, and is therefore also believed to be allowable.

Claims 6, 15 and 23

Claims 6, 15 and 23 have been rejected under 35 USC 103(a) as being unpatentable over Koyanagi in view of Okumura et al. (US6215617).

Koyanagi issued on August 21, 2004, less than one year prior to, or after, the filing date of the present invention. Therefore, the rejection of claims 6, 15 and 23 under 35 USC 103 is based on 35 USC 102(e) art. Applicants believe that Koyanagi is disqualified as prior art to the present invention under 35 USC 103(c). Please find attached a statement signed by an attorney of record that Koyanagi and the present application were both owned by and/or subject to an obligation of assignment to Hitachi Global Storage Technologies Netherlands BV at the time of invention of the subject

matter of the claimed invention in the present application. To support this assertion, the statement lists the assignment information of Koyanagi, currently in the process of being recorded with the USPTO. A copy of the assignment is also provided. As shown on the "Patent Assignment and Reservation" form, Kyoanagi was subject to an obligation to assign the rights thereof to Hitachi Global Storage Technologies Netherlands BV per an agreement between the parties dated December 31, 2002. Also attached is a copy of the original assignment of the present application, recorded on Reel 014799, Frame 0432 at the USPTO. Applicants believe that the statement and the supplemental assignment information is sufficient to overcome any evidentiary requirement of the Examiner, particularly in light of the following quotes from MPEP 706.02(1)(2)(II):

The following statement is sufficient evidence to establish common ownership of, or an obligation for assignment to, the same person(s) or organizations(s):

Applications and references (whether patents, patent applications, patent application publications, etc.) will be considered by the examiner to be owned by, or subject to an obligation of assignment to the same person, at the time the invention was made, if the applicant(s) or an attorney or agent of record makes a statement to the effect that the application and the reference were, at the time the invention was made, owned by, or subject to an obligation of assignment to, the same person.

...
For example, an attorney or agent of record receives an Office action for Application X in which all the claims are rejected under 35 U.S.C. 103(a) using Patent A in view of Patent B wherein Patent A is only available as prior art under 35 U.S.C. 102(e), (f), and/or (g). In her response to the Office action, the attorney or agent of record for Application X states, in a clear and conspicuous manner, that:

"Application X and Patent A were, at the time the invention of Application X was made, owned by Company Z."

This statement alone is sufficient evidence to disqualify Patent A from being used in a rejection under 35 U.S.C. 103(a) against the claims of Application X.

Applicants believe that the disqualification of Koyanagi renders claims 6, 15 and 23 and all claims depending therefrom allowable.

Claims 7, 9, 16, 18 and 24

Claims 7, 9, 16, 18 and 24 have been rejected under 35 USC 103(a) as being unpatentable over Koyanagi in view of Renken (US6741418).

As noted above with reference to claims 6, 15 and 23, Koyanagi is disqualified as prior art. Applicants believe that the disqualification of Koyanagi renders claims 6, 15 and 23 and all claims depending therefrom allowable.

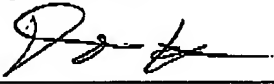
Claims 10 and 19

Claims 10 and 19 have been rejected under 35 USC 103(a) as being unpatentable over Koyanagi.

As noted above with reference to claims 6, 15 and 23, Koyanagi is disqualified as prior art. Applicants believe that the disqualification of Koyanagi renders claims 10 and 19 and all claims depending therefrom allowable.

Should the Examiner wish to discuss this matter further, the Examiner is invited to call the undersigned at (408) 971-2573. For payment of any fees due in connection with the filing of this paper, the Commissioner is authorized to charge such fees to Deposit Account No. 50-2587 (Order No. SJO920030158US1).

Respectfully submitted,

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